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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,341	07/22/2003	Stephan Aurich	071308.0452	7587

31625 7590 03/23/2005

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EXAMINER

EVANS, GEOFFREY S

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/624,341

Applicant(s)

AURICH ET AL.

Examiner

Geoffrey S Evans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-23 is/are allowed.
- 6) ☒ Claim(s) 1-5, 11 and 17 is/are rejected.
- 7) ☒ Claim(s) 6-10, 12-16 and 18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20030722.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

1. Claims 12, 16, and 18 are objected to because of the following informalities: In claim 12 there is no antecedent basis for "the rotating head". In claim 16 and claim 18 there is no antecedent basis for "the spindle". Appropriate correction is required.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Check et al. in U.S. Patent No. 4,782,203. Check et al. has a holding component (element 64) and a grooved recess in a pressure component (elements 72, 74; see figures 8 and 9).

4. Claims 1, 3, 4, 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Gamo et al. in U.S. Patent No. 5,045,661. Gamo et al. has a holding element (guide body 20; see column 2, lines 56-69) with a groove and a pressure component (element 40) that is comprised of a plate spring. The electromagnetic valve (element 92) indirectly controls the pressure force of the pressure component

5. Claims 1, 3, 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue in Japan Patent No. 63-62,617, published March 18, 1988. Inoue discloses a holding

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element with a groove (element 41, see figures 2 and 3) and a pressure component (element 42), wherein the pressure component can be adjusted.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 2,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in Japan Patent No. 63-62,617 in view of Tanaka in Japan Patent No. 63-312,024. Tanaka teaches having the two elements of a guide having a groove (see figures 5 and 6). It would have been obvious to adapt Inoue in view of Tanaka to provide this to place the electrode firmly in position.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in Japan Patent No. 63-62,317 in view of Fricke in U.S. Patent No. 5,214,260 or Iwasaki et al. in U.S. Patent No. 5,086,202. Fricke teaches making the wire guide member out of a

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wear resistant material, i.e. carbide. Alternatively Iwasaki et al. teaches using a ceramic made of Alumina (see column 5, line 4). It would have been obvious to adapt Inoue in view of Fricke or Iwasaki et al. to provide this to make the electrode guide more wear resistant.

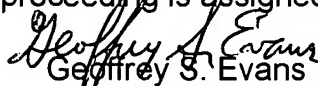
10. Claims 6-10, 12-16, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 19-23 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey S Evans whose telephone number is (571)-272-1174. The examiner can normally be reached on Mon-Fri 6:30AM to 4:00 PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571)-272-1171. The fax phone number for the organization where this application or proceeding is assigned is (703)-872-9306.

GSE


Geoffrey S. Evans
Primary Examiner
Group 1700